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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Masami Kugai

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EXAMINER

KOEMPEL THOMAS, BEATRICE L

ART UNIT

PAPER NUMBER

2132

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/699,990	Applicant(s) KUGAI, MASAMI	
	Examiner Bea Koempel-Thomas	Art Unit 2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 are pending in this application and presented for examination.
2. Amended abstract was received on 20 February 2004, and is accepted by the Examiner.

Objections

Specification

3. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.
4. The use of the trademark MagicGate™ has been noted in this application. It should be capitalized or include a proper trademark symbol, such as ™ or © following the word wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.
5. The disclosure is objected to because of the following informalities: The use of numerous abbreviations (acronyms) without definition, for example, MPU, FTP and VM. While these terms had an understood meaning in the art at the time the invention was made, the applicant's duty of public disclosure requires that such terms' meaning be fixed, which may be accomplished by inclusion of the term for which the acronym stands. Appropriate correction is required.

Drawings

6. The drawings are objected to because Figure 4 contains non-English language characters. An English language translation of the characters is necessary for applicant to claim subject matter supported by Figure 4.

7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claim 13 is objected to because of the following informalities: The “wherein” clause of claim 13 followed by the expression of intended results renders claim 13 unclear because it fails to set forth how the claimed method is to be performed. Additionally, a “whereby [wherein]

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clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.” (Minton v. Nat ’l Ass ’n of Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)). In order to further prosecution examiner considered claim 13 as though it contained a limitation of *selecting from among plural usage rights included in usage right information*. Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al., U.S. Patent No. 5,629,980 (hereinafter Stefik).**

11. **Regarding claim 1:** Stefik discloses a content utilizing method in a system including a user terminal (col. 16 lines 42-67, user interface connotes user terminal), a content server for providing a content (col. 4 lines 5-12, repository), a content processing apparatus for processing a content (col. 14 lines 7-27, processor), and a usage right control server for controlling a right of use of the content (col. 22-23 lines 33-8, depending on the embodiment, usage rights can be controlled by a document server, repository or authorization source), the method comprising:

a use requesting step of selecting a content to be used and a condition of use therefor in said user terminal and requesting a use of the content to said content server (col. 4 lines 5-23, repository operates in requester or server mode);

a content transmitting step of encrypting the content with a predetermined encrypting key in said content server (col. 15-16 Table 2, encryption: *see* Level 2, Basic Security and higher) and transmitting the content to said content processing apparatus (col. 42 lines 6-21, repository transmits to authorization server that decrypts and performs tests);

a license control information transmitting step of generating, in said content server, license control information including usage right information having identification information and condition of use of said selected content and user specific information, and executing transmission together with a decrypting key corresponding to said encrypting key to said usage right control server (col. 20 lines 7-30, file management rights control licenses, use, and distribution criteria; and col. 44 lines 23-64, *see* Licensed Distribution);

a ticket transmitting step of generating, in said content server, a ticket including an identifier of said license control information and transmitting it to said content processing apparatus (col. 22-23 lines 34-43, Tickets control access and transmission based on security level and AuthorizationID);

an authorization step of transmitting the identifier of said license control information from said content processing apparatus to said usage right control server, which communicates with said content processing apparatus based on the user specific information in the license control information corresponding to said identifier, thereby verifying an authorization for use of the user (col. 22-23 lines 33-8 and col. 41-42 lines 40-24, *see* Authorization Transactions);

a usage right information transmitting step of transmitting said usage right information and said decrypting key from said authorizing server to said content processing apparatus (col. 42 lines 6-21); and

a content processing step of decrypting said content by said decrypting key in said content processing apparatus and processing the decrypted content based on said usage right information (col. 42 lines 6-21).

12. **Regarding claim 2:** Stefik discloses that said authorization step includes:

an authorization data transmitting step of encrypting predetermined data with a second encrypting key corresponding to a user in said usage right control server to generate authorization data and transmitting such authorization data to said content processing apparatus (col. 27-29 lines 31-56, initiating sessions via user login, encryption using multiple keys, and transmitting registration data for authorization);

an authorization data returning step of decrypting said authorization data with a second decrypting key corresponding to said user in said content processing apparatus and returning the decrypted data to said usage right control server (col. 27-29 lines 31-56, decrypting and exchanging information to determine that repositories are bona fide); and

a judgment step of judging a successful verification of an authorization for use of said user in case said authorization data decrypted in said decryption step coincide with said predetermined data (col. 30-31 lines 61-4, verify requirements satisfied for all parts of transaction).

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13. **Regarding claims 3 and 8:** Stefik discloses a random number as predetermined data (col. 28 lines 32-63 “nonce”).

14. **Regarding claim 4:** Stefik discloses that said predetermined data include identification information of the user (col. 29 lines 42-56, user login/PIN) and the content (col. 41 lines 47-52, AuthorizationID based on digital work).

15. **Regarding claim 5:** Stefik discloses that said second encrypting key and said decrypting key are a same user key (col. 28-29 lines 64-17), and such user key is transmitted from said user terminal to said content server, then included in said ticket and transmitted to said content processing apparatus, and transmitted as said user specific information to said usage right control server (col. 31 lines 5-46, steps for transaction can include registration, trusted session, testing, usage rights, and requiring digital ticket).

16. **Regarding claim 6:** Stefik discloses that said second encrypting key is a public key of the user, and said second decrypting key is a secret key corresponding to said public key (col. 28-29 lines 64-17).

17. **Regarding claim 7:** Stefik discloses that said authorization step includes:

an authorization data transmitting step of generating predetermined authorization data in said usage right control server (col. 28 lines 32-63) and transmitting such authorization data to said content processing apparatus (col. 27-29 lines 31-56);

an authorization data returning step of encrypting said authorization data with a second encrypting key corresponding to said user in said content processing apparatus (col. 27-29 lines 31-56) and returning the encrypted data to said usage right control server (col. 42 lines 22-24);
and

a judgment step of decrypting the returned authorization data with a second decrypting key corresponding to said user (col. 28-29 lines 64-17) and judging a successful verification of an authorization for use of said user in case said decrypted authorization data coincide with said predetermined authorization data (col. 30-31 lines 61-4).

18. **Regarding claim 9:** Stefik discloses that said condition of use includes a kind of processing of the content (col. 4 lines 13-23, checking request against usage rights, processing request, and updating usage rights).

19. **Regarding claim 10:** Stefik discloses that said condition of use includes a fee charging method (col. 6-7 lines 51-5, associated fees are attached to digital work).

20. **Regarding claim 11:** Stefik discloses that said fee charging method includes a charging method according to an amount of use (col. 6-7 lines 61-5, all uses are billable).

21. **Regarding claim 12:** Stefik discloses that said content transmitting step transmits, together with said encrypted content, a program code to be executed by said content processing apparatus (col. 42 lines 6-21).

22. **Regarding claim 13:** Stefik discloses that said usage right information is capable of describing plural usage rights, and a usage right is selected among said plural usage rights for executing the content (col. 5-6 lines 50-14, i.e., copy and number of copies, transfer, loan, play, print, backup, and restore).

23. **Regarding claim 14:** Stefik discloses that said usage right information describes charge information for the execution of the usage right, and the method further comprises a charging step of executing a charging process according to said charging information when the usage right is executed (col. 6 lines 57-61, enforce billing for access to digital work).

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24. **Regarding claim 15:** Stefik discloses a charge checking step of checking a charge prior to the execution of said usage right (col. 29-30 lines 57-35, billing transaction completes before granting request).

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is:

- Bharat, U.S. Patent No. 6,577,735 B1 regarding backing-up data stored on a portable audio player.
- Kugai, U.S. Patent No. 6,799,271 B2 regarding authenticating a user and providing service.
- DeMello et al., U.S. Patent No. 7,017,189 B1 regarding activating a rendering device in a multilevel rights-management architecture.
- Margolus et al., U.S. Patent Publication No. 2004/0255140 A1 regarding a data repository and method for promoting network storage of data.
- Fischer, U.S. Patent No. 6,105,072 regarding validating traveling object-oriented programs with digital signatures.
- Araujo et al., U.S. Patent Publication No. 2002/0032725 A1 regarding remote access of an integrated virtual office via a web browser with remote network monitoring and management capabilities.
- Goland, U.S. Patent Publication No. 2003/0056114 A1 regarding networked device branding for secure interaction in trust webs on open networks.

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- Martinez et al., U.S. Patent No. 6,119,229 regarding a virtual property system.
- Ginter et al., U.S. Patent No. 5,892,900 regarding secure electronic management and electronic rights protection.
- Rabin et al., U.S. Patent No. 7,131,144 B2 regarding methods and apparatus for protecting information.
- Adams, U.S. Patent No. 6,351,815 B1 regarding a media-independent document security method and apparatus.

Please direct any inquiry concerning this communication or earlier communications from the examiner to Bea Koempel-Thomas whose telephone number is 571-270-1252. The examiner can normally be reached on Monday - Thursday & alternate Fridays; 0730 - 1700.


If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Gilberto Barron, at 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2/2/2007


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